

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of:

TAKETOMI, SUSAMU et al.

Serial No.: 09/679,856

Filed: October 5, 2000

GLASS COMPOSITE INCLUDING  
DISPERSED RARE EARTH IRON  
GARNET NANOPARTICLES

Docket No.: 30812

Group Art Unit No.: 1773

Examiner:

Assistant Commissioner of Patents  
Washington, D.C. 20231

Sir:

VERIFIED STATEMENT  
UNDER 37 C.F.R. § 5.25(a)(3)

I, R. W. TREWYN, do declare and state that:

1. I am the President of Kansas State University Research Foundation ("Foundation"). The Foundation is responsible for perfecting patent rights and commercialization of inventions made at Kansas State University in Manhattan, Kansas.
2. On or about September 13, 2000, the Foundation received an invention disclosure pertaining to the subject matter of the above-identified patent application. At or about the time of this disclosure, the Foundation learned that aspects of the disclosure had previously been published in a Japanese newspaper on October 6, 1999. Further, we learned that one of the inventors, Dr. Susamu Taketomi, and his Japanese employer, Matsumoto Yushi-Seiyaku Co. Ltd., had filed a patent application in Japan disclosing and claiming at least some of the subject matter of the above U.S. application (Japanese Application No. 2000-140930 filed

April 5, 2000). Upon information and belief, the other co-inventors, Drs. Kenneth Klabunde and Christopher Sorenson, had not learned of the existence of the earlier Japanese application until late August or early September, 2000. On or about September 13, 2000, I conferred by telephone with patent counsel on a variety of matters which may have included the existence of the earlier filed Japanese application and Japanese newspaper publication.

3. As a part of the disclosure process, a meeting was held on or about September 22, 2000, at the Foundation to determine whether a U.S. patent application should be filed. All three inventors were present at that meeting, along with myself, Gary Rabold and Ron Sampson. Mr. Rabold is Vice President of Mid-America Commercialization Corporation ("MACC") and Mr. Sampson is President of MACC. MACC is an organization in Manhattan, KS which cooperates with the Foundation in commercialization of inventions. At the September 22, 2000, meeting, the participants were aware of the need to file the U.S. application prior to October 6, 2000, in order to avoid having the Japanese publication become prior art against the U.S. application. Insofar as the effect of the earlier Japanese patent application was concerned, at some point shortly before or after the September 22, 2000, meeting, I was informed by the Foundation's patent counsel of the potential foreign filing license problem presented by the Japanese application. Specifically, after the September 22, 2000, meeting I wrote the Foundation's counsel, seeking a bid for preparation of the application. On September 14, 2000, the Foundation's counsel wrote me a letter fully explaining the foreign license issue.

- 
4. In light of the need to immediately file the U.S. application and thus avoid any potential bar arising from the October 6, 1999, Japanese publication, work was immediately commenced on the U.S. patent application, which involved intensive efforts to complete the application for filing prior to October 6, 2000. As indicated, the U.S. application was actually filed on October 5, 2000.
  5. I have been advised by our patent counsel that the filing receipt for the U.S. application was received December 11, 2000. In addition, Dr. Taketomi has been traveling after the filing of the U.S. application, and he did not return to Manhattan, KS until about December 21, 2000. Therefore, this license has been diligently sought under the facts of this case.
  6. To the best of my knowledge, the subject matter of the Japanese application was not under a secrecy order at the time it was filed abroad (April 5, 2000), and the subject matter of the Japanese and U.S. applications is not currently under a secrecy order.
  7. I further declare that all of my statements made herein are true and are made as a result of my own knowledge and experience, with the knowledge that willful false statements are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that any such willful false statements may jeopardize the validity of the above-referenced application or any patent issuing thereon.

Date: \_\_\_\_\_

2/23/01  
\_\_\_\_\_  
R. W. TREWYN